

REMARKS

This reply is being submitted with a Request for Continued Examination (RCE).

Telephone Interview Summary

The Applicants thank the Examiner for the telephonic interview on December 3, 2003. As discussed, the Applicants have cancelled claims 1, 21, and 25 without prejudice or disclaimer. During the interview, the Applicants addressed each of the three rejections made to claim 11. These arguments are presented below. The Applicants also agreed to amend the preamble of claim 11 as suggested.

New claims

The Applicants previously entered claims 68 to 168 in an amendment dated May 22, 2003. These claims were withdrawn by the Examiner. The Applicants cancel these claims without prejudice or disclaimer.[#]

New claims 169-190 and 194-206 depend directly or indirectly from claim 11. Accordingly, these claims read on the elected invention since they include narrower embodiments of claim 11. Claims 194-206 are multiply dependent since they depend, in the alternative, from claim 11 and claim 191. If the Examiner restricts claim 191 from claim 11, the Applicants respectfully request that claims 194-206 be examined as they depend from claim 11 alone.

New claims 191 and 209 are independent claims that differ in scope from claim 11. However, like claim 11, they are also methods for evaluating deacetylation of a substrate. Accordingly, these claims and claims dependent therefrom should be examined with claim 11. If the Examiner finds that restriction is appropriate, the Applicants respectfully request that a formal statement be made of record. See Geneva Pharmaceuticals, Inc. v. Glaxosmithkline Plc --- F.3d. ---, 2003 WL 22748633 (Fed. Cir. 2003).

[#] At least some newly entered claims are closely related or identical to some of the cancelled claims.

Rejections of claim 11 under 35 U.S.C. § 112 ¶ 2

I. On page 6 of the Action, dated September 5, 2003, the Examiner stated:

The rejection of claims 1, 6, 11, 21 and 25 under 35 U. S. C. 112, second paragraph, as being rendered vague and indefinite by the use of the term "NAD-dependent acetylation status" is maintained for reasons of record.

Claim 11, as presently amended, does not use the term "NAD-dependent acetylation status." The Applicants respectfully request that the rejection be withdrawn.

II. On page 7 of the Action, the Examiner stated:

Claims 1 and 11 are rejected under 35 U. S. C. 112, second paragraph, as being rendered vague and indefinite by the use of the term "alter(ing) the activity of a Sir2 protein" for the reasons set forth previously in the rejection of claim 1. It is unclear what "activity" is being altered. Applicant has argued that the specification discloses that Sir2 has deacetylase activity and hence said the aforementioned term is definite. However, since the specification describes multiple activities for Sir2 (see page 36 of the specification for example), it is unclear to which altered "activity" Applicant is referring.

The Applicants have amended claim 11 to clarify that the activity to which claim 11 refers is the deacetylase activity of Sir2. The Applicants respectfully request that the rejection be withdrawn.

III. On page 8 of the Action, the Examiner stated:

Claim 11 is rejected under 35 U. S. C. 112, second, paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: correlating the deacetylation of said substrate to a Sir2 activity (i.e. determining whether the deacetylation of the substrate is due to the Sir2 protein or the test agent).

Claim 11 has been amended. The preamble now indicates that the method is a method of evaluating the deacetylation of a substrate in the presence of a Sir2 protein, NAD or an NAD-like compound and an agent. This language both correctly describes the method of claim 11 and reflects its breadth since the method of claim 11 includes, in one implementation, an initial evaluation in a screen for compounds. An initial evaluation does not necessarily include assigning activity to a particular component. One may go on to perform additional correlations, but that is not required by the method of claim 11. The extent of the deacetylation of the

acetylated amino acid side chain in the substrate can indicate, for example, whether an agent is a candidate for a compound that modulates deacetylation activity of a Sir2 protein.

In view of the preamble of claim 11, as presently amended, the claimed method does not omit any essential steps.

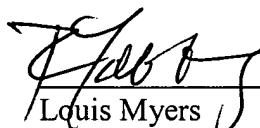
The Applicants respectfully submit that claim 11 and all newly added claims are in condition for allowance.

The Applicants do not concede any positions of the Examiner that are not expressly addressed above, nor do the applicants concede that there are not other good reasons for patentability of the presented claims or other claims. The cancellations and amendments in the claims are made without prejudice or disclaimer.

Please apply any other charges or credits to deposit account 06-1050, referencing attorney docket number 13407-016001.

Respectfully submitted,

Date: 1/5/04


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